UNITED STATES PATENT AND TRADEMARK OFFICE

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ART UNIT	PAPER NUMBER
3626	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	**Applicant(s)**
Office Action Summary	09/591,769	RAPPAPORT, ALAIN T.
	Examiner	**Art Unit**	
	RACHEL L. PORTER	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/11/09*.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,10-20,38-49 and 57-60* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-7, 10-20, 38-49 and 57-60* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendment received 3/11/09. Claims

1-7,10-19, 38-49, and 57-60 are pending.

Claim Rejections - 35 USC § 101

2.   U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-7, 10-19, and 57-59 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the

Office's guidance to examiners is that a §101 process must (1) be tied to a particular

machine or apparatus or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. *Diamond v. Diehr,* 450 U.S. 175, 184 (1981);

Parker v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409 U.S. *63,* 70

(1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876). If neither of these

requirements is met by the claim, the method is not a patent eligible process under

§101 and should be rejected as being directed to nonstatutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere

field-of-use limitation is generally insufficient to render an otherwise ineligible

method claim patent- eligible. This means the machine or transformation must

impose meaningful limits on the method claim's scope to pass the test. Second,

insignificant extra-solution activity will not transform an unpatentable principle into a

patentable process. This means reciting a specific machine or a particular

transformation of a specific article in an insignificant step, such a data gathering or

outputting, is not sufficient to pass the test.

It is noted that claim 1 recites "receiving information about a patient utililizing

a computer…" However, as stated above, reciting a specific machine or a particular

transformation of a specific article in an insignificant step, such a data gathering or

outputting, is not sufficient to pass the test. As such, the current language of claim 1

does not recite statutory subject matter. Claims 2-7,10-19, and 57-59 contain similar

deficiencies and fail to correct the problems of claim 1. Therefore, claims 2-7,10-19,

and 57-59 are also rejected.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

The claim recites the limitation/ the claim element "means to". However, it is

unclear whether the claim element is a means (or step) plus function limitation that

invokes 35 U.S.C. 112, sixth paragraph, because it does not use precise "means-plus-

function" wording. If applicant wishes to have the claim limitation treated under 35

U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase "means for" or "step for" in accordance

with these guidelines: the phrase "means for" or "step for" must be modified by

functional language and the phrase must **not** be modified by sufficient structure,

material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the

claim does **not** recite sufficient structure, material, or acts for performing the claimed

function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more

information, see MPEP § 2181.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-5,10-19, 38-40, 42,43, 46-49, and 57-60 are rejected under 35 U.S.C.

103(a) as being unpatentable over Spackman (US Patent No.6,263,330) in view of

Evans (US Patent No. 5,924,074).

[claim 1] Spackman discloses a method comprising:

- generating a set of queries for each of the one or more diagnostic codes using one or more combinations of the medical condition, a subset of the one or more concepts, and a subset of the one or more contexts as search criteria; (col. 4, lines 27-33; col. 7, lines 35-41)

- submitting the set of queries to one or more databases; (col. 10, lines 11-34)

- retrieving and storing a list of links to content in the one or more databases that satisfies the criteria specified in the queries; (col. 7, lines 41-67; col. 8, lines 36-48)

- associating each link in the list with the diagnostic code and context used in the query that retrieved the respective link; (col. 8, lines 60-col. 9, line 50)

- receiving information about a patient utilizing a computer, the information about the patient including diagnosis information based upon a diagnosis of the patient performed by a health care provider; (col. 4, lines 2-6; col. 10: 27-35)

- generating at least one document utilizing the computer, the at least one document containing the selected subset of links and the received information about the patient. (col. 8, lines 36-48)

Spackman discloses the method of query as explained above but does not expressly disclose establishing the diagnostic codes identifying medical conditions and associating the codes with the contexts. Evans teaches a data retrieval system/method further comprising:

- establishing one or more diagnostic codes, each identifying a medical condition; (Figure 20)

- associating one or more concepts for each diagnostic code that represent the

    associated medical condition in different terms; (Figure 20

- associating one or more contexts for each diagnostic code, each context

    representing contextual information deemed relevant to the medical condition

    identified by the code (Figure 20; col. 11, line 36-64)

Evans further discloses:

- matching the information about the patient to at least one diagnostic code and at

    least one context associated with the matching diagnostic code; (col. 8, lines,

    61-col. 9, lines 14; col. 11, lines 30-64)

- selecting a subset of the links associated with the at least one matching

    diagnostic code and the at least one matching context; (col. 11, lines 30-64—

    e.g. context: description, corresponding treatment)

Evans teaches a method wherein receiving data in the patient's records comprises

accessing procedure codes or diagnosis codes for procedures/diagnoses that the

patient has undergone/received and wherein the codes are CPT or ICD codes.

(column 9, lines 4-7, figure 20; column 11, lines 14-27). At the time of the Applicant's

invention, it would have been obvious to one of ordinary in the art to combine the

teachings of Spackman with the teachings of Evans to specifically include diagnostic

codes (e.g. ICD codes) and contextual information. One would have been motivated to

include this feature to facilitate the connection and transfer of medical data among

internal and external sources of patient information. (col. 3, lines 36-42)

[claims 2-4]   Spackman teaches a method that utilizes patient records and

disease information to retrieve store and/or retrieve information relating to a patient's

condition (col. 8, lines 66-col. 9, lines 20), but does not expressly disclose the use of

diagnostic codes, such as ICD codes. Evans teaches a data retrieval system/method

wherein receiving data in the patient's records comprises accessing procedure codes or

diagnosis codes for procedures/diagnoses that the patient has undergone/received and

wherein the codes are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11,

lines 14-27). At the time of the Applicant's invention, it would have been obvious to one

of ordinary in the art to combine the teachings of Spackman with the teachings of Evans

to specifically include diagnostic codes (e.g. ICD codes) among the patient information.

One would have been motivated to include this feature to facilitate a treating healthcare

provider's access to a wide range of critical medical data relating to his/her patients.

 [claim 5] Spackman teaches a method wherein the information about the patient

further comprises information selected from the group consisting of the patient's

personal information, prescription information, laboratory information, procedures

information, materials and supplies information and injection information. (Spackman:

col. 9, lines 1-20)

[claim 10] Spackman discloses the method of claim 1 wherein generating the set of

queries comprises: constructing a set of queries based on the information received. (col.

10, lines 11-34)

[claims 11-16]

Spackman teaches a method that utilizes patient records and disease information to

retrieve store and/or retrieve information relating to a patient's condition (col. 8, lines 66-

col. 9, lines 20), but does not expressly disclose the use of diagnostic codes, such as

ICD codes. Evans teaches a data retrieval system/method wherein receiving data in

the patient's records comprises accessing procedure codes or diagnosis codes for

procedures/diagnoses that the patient has undergone/received and wherein the codes

are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11, lines 14-27). Evans

further discloses:

- matching the information about the patient to at least one diagnostic code and at

  least one context associated with the matching diagnostic code; (col. 8, lines,

  61-col. 9, lines 14; col. 11, lines 30-64)

- selecting a subset of the links associated with the at least one matching

  diagnostic code and the at least one matching context; (col. 11, lines 30-64—

  e.g. context: description, corresponding treatment)

Evans teaches a method wherein receiving data in the patient's records comprises

accessing procedure codes or diagnosis codes for procedures/diagnoses that the

patient has undergone/received and wherein the codes are CPT or ICD codes.

(column 9, lines 4-7, figure 20; column 11, lines 14-27). At the time of the Applicant's

invention, it would have been obvious to one of ordinary in the art to combine the

teachings of Spackman with the teachings of Evans to specifically include diagnostic

codes (e.g. ICD codes) and contextual information. One would have been motivated to

include this feature to facilitate the connection and transfer of medical data among

internal and external sources of patient information. (col. 3, lines 36-42)

[claim 17]   Spackman discloses the method of claim 1 further comprising: allowing

the patient to access the at least one document via a computer network. (col. 5, lines

57-67)

[claim 18]   Spackman discloses the method of claim 17 further comprising: allowing

the patient to provide feedback or comments with respect to the information contained

in the at least one document. (col. 10, lines 53-63)

[claim 19]   Spackman discloses the method of claim 18 wherein the computer

network is selected from the group consisting of a local area network, a wide area

network, and the Internet. (col. 5, lines 57-67)

[claim 58]   Spackman discloses a method wherein the queries may include contextual

information relating to at least one of a weight, an age and a sex. (col. 9, lines 47-67)

[claim 59] Spackman discloses the method of claim 1 wherein the at least one

document includes a list of data sources associated with a parent diagnosis code if a list

of data sources associated with a child diagnosis code cannot be identified, wherein the

parent diagnosis code is included in a first classification in a hierarchy of diagnosis code

classifications that includes a second classification that includes the diagnosis code.

(col. 8, lines 60-col. 9, line 50)

[claim 38]   Spackman discloses a system comprising:

- a first database that stores data corresponding to a specific code; and (col. 6,

  lines 1-15; 65-67))

- a first server that receives information about a patient from at least one source,

  the information about the patient including at least one code (col. 5,lines 51-67),

  the first server retrieves from the first database at least one list of content links

  based upon the at least one code and generates at least one document

  containing the at least one list of content links retrieved from the first database,

  (col. 6, lines 18-61) wherein the first server selects a set of existing queries that

  correspond to information about a medical procedure to retrieve the at least one

  list of content links; (col. 8, lines 36-48)

Spackman discloses the system for querying as explained above but does not

expressly disclose establishing the diagnostic codes identifying medical conditions and

associating the codes with the contexts. Evans teaches a data retrieval system further

comprising:

- a database that stores a set of diagnostic codes representing medical

  conditions,(Figure 20) each code having stored therewith at least one conceptual

  equivalency and at least one context relevant to the medical condition, (figure

  20) wherein each diagnostic code is associated with a set of queries constructed

  using one or more combinations of the medical condition, one of the conceptual

  equivalencies, and one of the contexts as search criteria, code (Figure 20; col.

  11, line 36-64)

- and wherein the first database retrieves and stores a set of links to content in external data sources that satisfies the set of queries, each link associated with the diagnostic code and context that facilitated retrieval of the respective link; and (col. 8, lines, 61-col. 9, lines 14; col. 11, lines 30-64—e.g. context: description, corresponding treatment)

Evans teaches a method wherein receiving data in the patient's records comprises accessing procedure codes or diagnosis codes for procedures/diagnoses that the patient has undergone/received and wherein the codes are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11, lines 14-27). At the time of the Applicant's invention, it would have been obvious to one of ordinary in the art to combine the teachings of Spackman with the teachings of Evans to specifically include diagnostic codes (e.g. ICD codes) and contextual information. One would have been motivated to include this feature to facilitate the connection and transfer of medical data among internal and external sources of patient information. (col. 3, lines 36-42)

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[claim 39]   Spackman discloses the system of claim 38 wherein the at least one document generated is stored in a second database. (col. 7, lines 49-56; col. 8, lines 44-48)

[claim 40]   Spackman discloses the system of claim 38 wherein the at least one document is made accessible to the patient via a computer network. (col. 5, lines 51-67)

[claim 42]   Spackman discloses the system of claim 38, wherein the first server

includes a machine-readable medium comprising instructions which, when executed by

a machine, cause the machine to perform operations, the instructions to comprise:

- logic to receive the information about the patient from the at least one source;

  (col. 4, lines 2-6; col. 10: 27-35)

- logic to generate a set of queries based upon the at lease one definition that

  corresponds to the at least one code received; and (col. 4, lines 27-33; col. 7,

  lines 35-41)

- logic to execute the set of queries to retrieve from the first database the at least

  one list of content links that corresponds to the set of queries. (col. 7, lines 41-67;

  col. 8, lines 36-48)

[claim 43]   Spackman discloses the system of claim 38 wherein the at least one list of

content links that is stored in the first database is identified using a set of queries

generated from the at least one definition that is associated with the at least one code.

(col. 6, lines 65-67)

[claim 46] The limitations of claim 46 are addressed by the rejections of claims 38 and

42.

[claim 48] Spackman discloses the limitations of claim 46 wherein the diagnosis

information comprises at least one description describing the patient's conditions or

problems based upon the diagnosis performed by the health care provider. (col. 9, line 46-67; col. 10, lines 21-34)

[claim 49] Spackman discloses the limitations of claim 48 wherein performing the query function comprises: generating a set of queries containing query criteria based on the received information about the patient; and executing the set of queries to retrieve from the database the list of data sources matching the query criteria. (col. 10, lines 46-67)

[claim 47]   The limitations of claim 47 are addressed by the rejection of claims 11-16 and 46, and incorporated herein.

[claim 57] Spackman teaches the method of claim 13 wherein the diagnosis description describes an agent that is causally related to the diagnosis information. (col. 6, lines 51-60; col. 9, lines 47-67)

[claim 60] The limitations of claim 60 are addressed by the rejection of claim 1.

7.   Claims 6-7, 41, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spackman and Evans in view of Kirk et al (US 5,768,578).

[claims 6-7] Spackman and Evans discloses the method of claim 1 as explained in the rejection of claim 1, but does not expressly disclose that the data source is referenced by an address corresponding to a location where the data source resides or that this address comprises Uniform Resource Locator (URL). Kirk discloses a query processing method wherein the location where the data source resides comprises a Uniform Resource Locator (URL). (Figure 8, col. 33, lines 10-42; col. 34, lines 21-36). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Spackman with the teaching of Kirk. As suggested by Kirk, one would have been motivated to include this feature to allow a user to more easily navigate through information sources which are most relevant to his/her request. (Kirk: col. 2, lines 55-63)

[claim 41] Spackman and Evans teach the system of claim 38, over a computer network (col. 5, lines 51-57, but does not expressly discloses that the computer network is the Internet. Kirk discloses a system wherein the computer network is the internet. (Figure 8, col. 33, lines 10-42; col. 34, lines 21-36) At the time of the applicant's invention it would have been obvious to one of ordinary skill in the art to modify the system of Spackman to use the Internet. One would have been motivated to include this feature to allow the user to have access to computer network with a large distributed body of information. (col. 1, lines 19-22)

[claims 44-45]   Spackman and Evans disclose the system of claim 38 as explained in

the rejection of claim 38, but does not expressly disclose that the set of queries is used

to at least one database on the WWW. Kirk discloses the system of claim 38 wherein

the set of queries is used to search at least one database on the World Wide Web to

identify a potential list of content links. (Figure 8, col. 33, lines 10-42; col. 34, lines 21-

36). At the time of the Applicant's invention, it would have been obvious to one of

ordinary skill in the art to modify the method of Spackman with the teaching of Kirk. As

suggested by Kirk, one would have been motivated to include this feature to provide a

computer network with a large distributed body of information. (col. 1, lines 19-22) while

allowing a user to more easily navigate through information sources which are most

relevant to his/her request. (Kirk: col. 2, lines 55-63)

Response to Arguments

8.   Applicant's arguments with respect to the claims have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to RACHEL L. PORTER whose telephone number is

(571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax

phone number for the organization where this application or proceeding is assigned is

571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626